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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,186	05/24/2001	Yook-Kong Yong		9650
7590	09/20/2005			
Yook-Kong Yong 5 Golf View Drive Princeton, NJ 08540			EXAMINER JEFFERY, JOHN A	
			ART UNIT 3742	PAPER NUMBER
DATE MAILED: 09/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/863,186	Applicant(s) YONG ET AL.	
	Examiner John A. Jeffery	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgement of Elected Claims Without Traverse***

Applicant's election of Group I, claims 1, 2, and 6<sup>1</sup> without traverse is acknowledged. Accordingly, claims 3-5 and 7 are withdrawn from consideration as being directed to a nonelected invention.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Abstract***

The abstract of the disclosure is objected to because of the following informalities:

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<sup>1</sup> Applicant's amendment to the preamble of claims 2 and 6 converted the claims from independent claims to dependent claims such that claims 2 and 6 now depend from claim 1. In view of this amendment, claims 2 and 6 are now properly grouped in Invention Group I.

The amendment to the preambles of claims 3-5 and 7, however, did not convert those claims to dependent claims (specifying the claims are "subcombination[s] of claim 1"). In short, the recitation in claims 3-5 and 7 that the database management system is a "subcombination of claim 1" does not incorporate each and every limitation from claim 1 to reasonably establish the claims as dependent on

(1) The abstract is too long and must be shortened to less than 150 words.

(2) All occurrences of legal phraseology, such as "means" and "said," must be changed to plain language.

Correction is required. See MPEP § 608.01(b).

***Revised Amendment Practice Under 37 CFR 1.121***

Applicant is reminded of the revised amendment practice under 37 CFR 1.121 effective July 30, 2003. The seven permissible status identifiers set forth in 37 CFR 1.121(c) are:

**(Original);**

**(Currently amended);**

**(Canceled);**

**(Previously presented);**

**(New);**

**(Not entered); and**

**(Withdrawn).**

For proper format, (1) insertions must be designated by underlining, and (2) deletions must be designated by strikethroughs. See the USPTO web site at

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claim 1 in accordance with 35 USC § 112, fourth paragraph. Accordingly, claims 3-5 and 7 remain independent claims notwithstanding the amendment to their preambles.

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.htm> for more information on proper amendment practice.

***Substitute Specification Not Entered***

The substitute specification filed Apr. 8, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because:

- (1) the statement as to a lack of new matter under 37 CFR 1.125(b) is missing;  
and
- (2) a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy).

Accordingly, applicant must provide a new substitute specification for entry including:

- (1) a clean copy of the substitute specification;
- (2) a marked-up copy of the substitute specification clearly showing all changes made (i.e., with underlining (insertions) and strikethroughs (deletions)); and
- (3) a statement that the substitute specification does not include new matter in accordance with 37 CFR 1.125(b).

***Disclosure Objections***

The disclosure is objected to because of the following informalities:

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Claims 3-5 and 7: For the reasons set forth in Footnote 1 of this Office Action, applicant must delete "as a subcombination of claim 1" in lines 1-2 of each claim for clarity.

Entire disclosure: Applicant must change the single spacing of all text to double spacing for clarity.

Appropriate correction is required.

### ***Claim Objections***

Claims 2 and 6 are objected to because of the following informalities:

Claims 2 and 6: In line 1, ", furthermore" must be deleted. In line 2, the phrase "and further including means" must be inserted after "claim 1," for clarity.

Claim 2: In line 3, "PDA" must be spelled out for clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, and 6: The claims are incomplete since they do not end with a period. Consequently, it is unclear whether applicant intended for additional limitations

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to be claimed following the last line, or if a period was intended. For examination purposes, the examiner presumes that applicant intended (1) the semicolons in claims 1 and 2 to be periods respectively, and (2) the phrase “; and” to be a period in claim 6.

Claim 2: No antecedent basis exists for “the PDA.” Applicant must therefore change “the PDA” to “a PDA” in line 3. No antecedent basis exists for “the various said objects” in lines 4-5. No antecedent basis exists for “the grid map” in line 5.

Claim 6: The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim must be in one sentence form only. Note the format of the claims in the patents cited.

### ***Joint Inventors -- Common Ownership Presumed***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

***Claim Rejections - 35 U.S.C. § 103(a)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuesters (US 6,113,504) in view of Helderan (US 5,743,815). Kuesters (US 6,113,504) discloses a golf ball locator system comprising a golf ball 10 with an electromagnetic transmitter 22 therein. The electromagnetic transmitter can emit RF. See col. 4, lines 10-21. A grid of receivers 54-78 located on the golf course receives electromagnetic energy from the golf ball and sends the data to processor 82 to generate location coordinates via triangulation. Processor 82 then transmits the golf ball location data to a portable display unit 90 (i.e., a PDA) to inform the user the golf ball's precise location. See Fig. 5, 6 and col. 6, line 5 – col. 8, line 21. The system can also calculate distance between the hole (or other landmark) and the ball. Moreover, the system can determine coordinates of the golf cart or player (and therefore the PDA location) relative to the ball. See col. 9, lines 8-63.

The claims differ from Kuesters (US 6,113,504) in calling for (1) a passive transponder in the golf ball and (2) transceivers. But providing a passive transponder in a golf ball that is energized and whose signal is received by a transceiver is well known



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in the art. Helderma (US 5,743,815), for example, discloses in Fig. 3 a golf ball 14 with passive transponder 12 (col. 3, lines 8-9). The golf ball's transponder is energized by transceiver 24, and the resulting signal generated by the transponder is received by the transceiver (note transmitter 26 and receiver 28 within transceiver 24). By employing a passive transponder in the golf ball that is energized by the transceiver, no internal energy sources are required for the golf ball's transponder thus reducing weight and cost. In view of Helderma (US 5,743,815), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a passive transponder within the golf ball and utilize a grid of transceivers in lieu of receivers in Kuesters (US 6,113,504) so that the golf ball's transponder was energized externally, thus obviating the need for internal energy sources for the golf ball's transponder, thus reducing weight and cost.

### ***Other Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should (1) separately consider the art, and (2) consider the art together with the previously cited prior art for potential applicability under 35 U.S.C. §§ 102 or 103 when responding to this action. JP 366, JP 041, US 959, FR 556, US 057 (Fig. 12), US 880, US 199, US 549, WO 768, US 547, US 057, US 404, US 411, WO 945 disclose golf ball locating systems relevant to the instant invention.

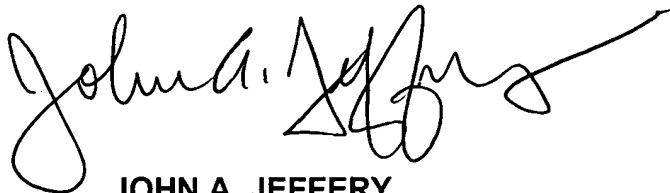
### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (571) 272-4781. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (571) 272-4777. All faxes should be sent to the centralized fax number at (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "John A. Jeffery", with a long, sweeping horizontal stroke extending to the right.

**JOHN A. JEFFERY  
PRIMARY EXAMINER**

**9/14/05**